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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/006,936	12/05/2001	Herman Chien	83531-322	9281
22504	7590	12/30/2008		
DAVIS WRIGHT TREMAINE, LLP/Seattle 1201 Third Avenue, Suite 2200 SEATTLE, WA 98101-3045			EXAMINER SAMS, MATTHEW C	
			ART UNIT 2617	PAPER NUMBER
			MAIL DATE 12/30/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/006,936

**Applicant(s)**

CHIEN, HERMAN

**Examiner**

MATTHEW SAMS

**Art Unit**

2617

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 October 2008.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 10, 17, 20-24, 28, 30-33 and 37-39 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 10, 17, 20-24, 28, 30-33 and 37-39 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/14/2008 has been entered.
2. Claims 10, 21, 23, 28, 30, 32 and 39 have been amended.
3. Claims 4-8, 25 and 36 have been canceled.

### ***Response to Arguments***

4. Applicant's arguments filed 10/14/2008 have been fully considered but they are not persuasive.
5. In response to the applicant's argument regarding claim 10 and its dependents, the examiner respectfully disagrees.

The rejection to claim 10 is maintained because the claim is an apparatus directed to a "content provider", wherein the patentability of the "content provider" is dependent upon the aspects of the "content personalization interface" and the "processor", not the surrounding environment of the "content provider", which is described at length within the preamble. It is obvious to one of ordinary skill in the art

that the content provider described within Parsons in view of Peck and Demello can be implemented within the environment described within the preamble.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 28, 30-33 and 39 recites the limitation "communication device" in claim  
10. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 10, 17, 20, 28-33 and 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parsons et al. (US-6,310,889 hereafter, Parsons) in view of Peck (US-6,606,491) and Demello et al. (US-2001/0036224 hereinafter, Demello).

Regarding claim 10, Parsons teaches a content provider configured to communicate with one or more mobile stations (Col. 1 line 54 through Col. 2 line 32) over a network, the content provider comprising:

a content personalization interface configured to receive the anonymous user identifier from at least one of the mobile stations (Col. 8 lines 56-61) and

a processor configured to use the anonymous user identifier to personalize content for the at least one of the mobile stations, and to provide the personalized content to the at least one of the mobile stations. (Col. 8 line 56 through Col. 9 line 29) Parsons teaches determining the user by varying methods (Col. 8 lines 56-61), but differs from the claimed invention by not explicitly reciting the user identifier is based on a SIM serial number, unrelated to the device identifier and associated with the SIM serial number.

In an analogous art, Peck teaches using at least in part, a serial number of a SIM assigned to the SIM by a manufacturer of the SIM (Col. 5 lines 21-33 and Col. 8 lines 50-52 "the 32-bit SIM-based ESN can be generated by the operator or SIM card manufacturer") as an anonymous user identifier (Col. 3 lines 51-57, Col. 4 lines 53-62 and Col. 5 lines 21-33), authentication information for authenticating the mobile station with the network (Col. 7 line 38 "AUTHR"), wherein the anonymous user identifier is unrelated to the device identifier. (Col. 3 lines 51-57) At the time the invention was made, it would have been obvious to one of ordinary skill in the art to implement the invention of Parsons after modifying it to incorporate the user identifier based on a SIM serial number of Peck. One of ordinary skill in the would have been motivated to do this since SIM cards can be removable, switched between phones and still have the user receive the requested content formatted for the phone. (Col. 2 lines 11-32)

Parsons in view of Peck differs from the claimed invention by not explicitly reciting the anonymous user identifier is unrelated to the authentication information.

In an analogous art, Demello teaches a system and method for delivering personalized content to an anonymous user (Abstract), which includes creating an anonymous user identifier that is unrelated to a device identifier and authentication information. (Page 3 [0035] "one or more specific identifiers on Mediation Servers" & [0038] "The anonymous identification must not allow the determination of the identity of the wireless users") At the time the invention was made, it would have been obvious to one of ordinary skill in the art to implement the content provider of Parsons in view of Peck after modifying it to incorporate the use of an anonymous user identifier of Demello. One of ordinary skill in the art would have been motivated to do this since it enables a mobile user to receive personalized information while maintaining anonymity with the content providers. (Demello Page 2 [0019])

Regarding claim 17, Parsons in view of Peck and Demello teaches a personalization interface is configured to receive the device identifier and the processor is configured to use the device identifier to personalize device-specific content for the at least one of the mobile stations, and to provide the personalized device-specific content to the at least one of the mobile stations. (Parsons Col. 2 lines 11-32, Col. 8 lines 56-61, Peck Col. 3 lines 51-57, Col. 4 lines 53-62 and Col. 5 lines 18-21)

Regarding claim 20, Parsons in view of Peck and Demello teaches the anonymous user identifier is the SIM serial number (Peck Col. 3 lines 51-57, Col. 4 lines 53-62 and Col. 5 lines 21-33) assigned, at least in part, by the manufacturer of the SIM.

(Peck Col. 8 lines 50-52 "the 32-bit SIM-based ESN can be generated by the operator or SIM card manufacturer")

Regarding claim 28, Parsons in view of Peck and Demello teaches wherein the authentication information includes a MSISDN number. (Peck Col. 1 lines 33-54, Col. 5 lines 18-32 and Col. 7 lines 36-49)

Regarding claim 30, Parsons in view of Peck and Demello teaches the authentication information includes a mobile subscriber identity. (Peck Col. 2 lines 30-61)

Regarding claim 31, Parsons in view of Peck and Demello teaches the mobile subscriber identity is an international mobile subscriber identity (IMSI). (Peck Col. 2 lines 30-48)

Regarding claim 32, Parsons in view of Peck and Demello teaches the authentication information includes a mobile subscriber identity (Peck Col. 2 lines 39-42) and a mobile station number. (Peck Col. 1 lines 38-39 MIN, Col. 1 lines 49-54, Col. 2 lines 42-57 and Col. 3 lines 51-57)

Regarding claim 33, Parsons in view of Peck and Demello teaches the mobile subscriber identity is an international mobile subscriber identity (IMSI) and the mobile station number is a mobile station ISDN number (MSISDN). (Peck Col. 2 lines 30-48) It is well known to one of ordinary skill in the art that the MSISDN is the telephone number of the SIM card, including the country code.

Regarding claim 37, Parsons in view of Peck and Demello teaches the content personalization interface is configured to receive the anonymous personalization data from the at least one of the mobile stations; (Parsons Col. 2 lines 11-32, Col. 8 lines 56-61, Peck Col. 3 lines 51-57, Col. 4 lines 53-62 and Col. 5 lines 18-21) and

the processor is configured to use the device identifier to personalize device-specific content for the at least one of the mobile stations, and to provide the personalized device-specific content to the at least one of the mobile stations. (Parsons Col. 2 lines 11-32, Col. 8 lines 56-61, Peck Col. 3 lines 51-57, Col. 4 lines 53-62 and Col. 5 lines 18-21)

Regarding claim 38, Parsons in view of Peck and Demello teaches a database (Parsons Fig. 3 [38a & 38b]) configured to store the anonymous personalization data received by the content personalization interface from the at least one of the mobile stations and to provide the anonymous personalization data to the processor. (Parsons Col. 9 lines 4-29 and Col. 14 lines 40-44)

Regarding claim 39, Parsons in view of Peck and Demello teaches the SIM further comprises the authentication information. (Peck Col. 7 lines 36-45)

***Allowable Subject Matter***

10. Claims 21-24 are allowed.

11. The following is an examiner's statement of reasons for allowance: Claim 21 recites, *inter alia*, a method for providing personalized content to a wireless device coupled to a wireless communication network having a content provider, the wireless

device comprising a device identifier, authentication information, and a SIM having a serial number assigned, at least in part, by a manufacturer of the SIM, the wireless device being configured to transmit authentication information and an anonymous user identifier to the wireless communication network, the anonymous user identifier being based, at least in part, on the serial number and being unrelated to both the device identifier and the authentication information, the method comprising receiving the authentication information, performing an authentication process based on the authentication information and not based on the anonymous user identifier, the authentication process authenticating the mobile station with the wireless communication network, after the mobile station is authenticated with the wireless communication network at the content provider, receiving an anonymous user identifier from the wireless device over the wireless communication network, selecting content based on the anonymous user identifier and providing the selected content to the wireless device over the wireless communication network. The applicant's claimed invention provides a unique combination that is neither taught nor suggested by the prior art.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW SAMS whose telephone number is (571)272-8099. The examiner can normally be reached on M-F 8-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester Kincaid can be reached on (571) 272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MCS  
12/20/2008

/Lester Kincaid/  
Supervisory Patent Examiner, Art Unit 2617